

**REMARKS**

This responds to the Office Action dated April 5, 2007. No claims are amended, canceled, or added; as a result claims 1-26 are pending in this application.

**§102 Rejection of the Claims**

Claims 1-6, 8-12, 15-18 and 23-26 were rejected under 35 U.S.C. § 102(e) for anticipation by Kim (U.S. Patent No. 6,778,040). Applicant respectfully traverses. The Office Action fails to establish a *prima facie* case of anticipation because Kim does not teach all of the elements presently recited in the claims. The identical invention must be shown in as complete detail as is contained in the claim.<sup>1</sup>

Applicant cannot find in Kim any disclosure of, among other things, one or more ceramic chip capacitors mounted on the printed circuit interconnect substrate to face inward into the hermetically sealed interior,

as presently recited in claim 1.

Kim states that “additional pattern lines are formed on the top surface of the insulating substrate 40 so as to allow filter devices to be mounted.”<sup>2</sup> Kim also refers to “assigning a shielding function to a bottom surface on which filter devices are not mounted.”<sup>3</sup> Kim further cites U.S. Pat. No. 5,959,829 (the ‘829 patent) for construction of a feed-through filter.<sup>4</sup> The ‘829 patent states that an important aspect of the invention is the location of the chip capacitors 42 directly at the point of lead penetration of the header of the implantable device, and that the efficacy of the chip capacitor filter … is based upon the attenuation of the RF carrier before it can enter into the sealed housing for the electronic circuitry.”<sup>5</sup> Thus, Kim with the ‘829 patent describes placing filter devices, such as capacitors, on the top surface that is outside a sealed housing.

---

<sup>1</sup> M.P.E.P. §2131 citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1990)

<sup>2</sup> Kim, col. 7 lines 38-40.

<sup>3</sup> Kim, col. 1 lines 11-12.

<sup>4</sup> Kim., col. 2 lines 7-8.

<sup>5</sup> ‘829 patent, col. 7 lines 34-41.

The Office Action states that the capacitors (C1, C2) are covered by the “seal 60” and grounding part (44), and thus, the capacitors being formed are inside the seal and ground parts.<sup>6</sup> However, Kim refers to item 60 as a buffer 60 instead of a seal, and Figure 14C of Kim shows the buffer 60 on the top surface. Kim further states that “it is difficult to assign a shielding function to the top surface of the insulating substrate 40,” and “in consideration of this difficulty, the bottom surface ground part 44 for electromagnetic shielding is implemented on the bottom surface of the insulating substrate 40.”<sup>7</sup> Therefore, Kim in fact teaches away from chip capacitors mounted on the printed circuit interconnect substrate to face inward into the hermetically sealed interior, as recited in claim 1.

Applicant respectfully requests reconsideration and allowance of claims 1-6, 8-12, 15-18, and 23-26.

Additionally, Applicant reserves the right to swear behind the Kim reference and any other references cited under 35 U.S.C. § 102(e). Statements distinguishing the claimed subject matter over the cited references are not to be interpreted as admissions that the references are prior art.

#### §103 Rejection of the Claims

1. Claims 19-22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kim (U.S. Patent No. 6,778,040) in view of Brendel et al. (U.S. Patent No. 6,529,103, “Brendel”). Applicant respectfully traverses the rejection.

Claims 19-22 ultimately depend on base claim 1. As discussed above, Applicant believes claim 1 to be allowable at least for the reason that Kim does not teach or suggest all of the elements recited in the claim. The addition of Brendel fails to disclose the missing elements.

Also, the M.P.E.P. states that Graham v. John Deere Co. should be followed in the consideration and determination of obviousness under 35 U.S.C. § 103. The four factual inquiries enunciated in Graham include ascertaining the differences between the prior art and the claims at issue.<sup>8</sup> Ascertaining the difference between the prior art and the claims at issue

---

<sup>6</sup> Office Action, pg. 6 Sect. 6.

<sup>7</sup> Kim, col. 7 lines 40-47.

<sup>8</sup> M.P.E.P. § 2141.

includes considering a reference in its entirety, including disclosures that teach away from the claimed invention.<sup>9</sup>

The '829 patent, cited in Kim as disclosing construction of a feed-through filter in detail, states that an important aspect of the invention is the location of the chip capacitors 42 directly at the point of lead penetration of the header of the implantable device, and that the efficacy of the chip capacitor filter ... is based upon the attenuation of the RF carrier before it can enter into the sealed housing for the electronic circuitry."<sup>10</sup> Thus, the '829 patent describes placing the chip capacitor filter outside a sealed housing to attenuate the RF carrier.

Further, Kim states that a chip capacitor mounting circuit for an EMI filtering function is implemented on the top surface of the insulating resin substrate.<sup>11</sup> Kim also states that "it is difficult to assign a shielding function to the top surface of the insulating substrate 40," and "in consideration of this difficulty, the bottom surface ground part 44 for electromagnetic shielding is implemented on the bottom surface of the insulating substrate 40."<sup>12</sup>

Therefore Kim, with the '829 patent, teaches away from chip capacitors mounted on the printed circuit interconnect substrate to face inward into the hermetically sealed interior, as recited in claim 1 and incorporated into claims 19-22.

Applicant respectfully requests reconsideration and allowance of claims 19-22.

2. Claims 13-14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kim (U.S. Patent No. 6,778,040) in view of Andresakis et al. (U.S. Patent No. 6,657,849, "Andresakis"). Applicant respectfully traverses the rejection.

Claims 13-14 depend on base claim 1. As discussed above, Applicant believes claim 1 to be allowable at least for the reason that Kim does not teach or suggest all of the elements recited in the claim. The addition of Andresakis fails to disclose the missing elements. Additionally, as discussed above, Kim teaches away from the subject matter recited or incorporated into the claims. Applicant respectfully requests reconsideration and allowance of claims 13-14.

<sup>9</sup> M.P.E.P. § 2141.02.

<sup>10</sup> '829 patent, col. 7 lines 34-41.

<sup>11</sup> Kim, col. 11 lines 14-16.

<sup>12</sup> Kim, col. 7 lines 40-47.

3. Claim 7 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Kim (U.S. Patent No. 6,778,040) in view of Chee (U.S. Patent No. 6,657,133). Applicant respectfully traverses the rejection.

Claim 7 depends on base claim 1. As discussed above, Applicant believes claim 1 to be allowable at least for the reason that Kim does not teach or suggest all of the elements recited in the claim. Additionally, as discussed above, Kim teaches away from the subject matter recited in the claims. Applicant respectfully requests reconsideration and allowance of claim 7.

### CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 371-2172 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

NICK A. YOUKER ET AL.

By their Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.  
P.O. Box 2938  
Minneapolis, MN 55402  
(612) 371-2172

Date July 5, 2007

By Paul J. Urbanski  
Paul J. Urbanski  
Reg. No. 58,351

**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 1 day of July 2007.

John D. Gephart - Wachtell

Name

Signature

John D. Gephart - Wachtell